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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,122	08/20/2003	Robert Mark Zerhusen	8266-1126	6524

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EXAMINER

LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,122

Applicant(s)

ZERHUSEN ET AL

Examiner

Jong-Suk (James) Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restriction

1. Applicant's election of Fig. 14 directed to claims 1-15 and 18-30 filed 3/4/2004 is acknowledged. Upon further consideration, it is understood that the "notches" in claims 1 and 21, and the "apertures" in claims 11 and 27 are considered to be the same element of the siderail covering although they are not clarified by Applicant and further the term, "notch" lacks of antecedent basis in the specification.

Claims 16 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, there being no allowable generic or linking claim.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "notches" in claim 1, line 2 and claim 21, line 3 respectively.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 1, 11, 21 and 27: The limitation, “notches” in claim 1 and 21 and “apertures” in claim 11 and 27 renders the claim indefinite and confusing because it is not clear as to whether they are relating to the same element or distinguished from each other.

Claim terminology should be consistent with the claim scope.

Claims 2-10, 12-15, 18-20, 22-26, 28-30 are also considered to be indefinite because they are dependent upon above mentioned independent claims, respectively

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1, 4, 5, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Pierzina (US 6,279,795).

The preamble limitation, "for use with a bed" in claim 21, line 1 is intended use and no patentable weight is given to the preamble.

Pierzina discloses a shoulder strap (24) comprising a body comprising a flexible material, which is made of polypropylene/foam, having a plurality of adjustably sized notches (34), the body having a longitudinal axis and a first longitudinal end (30), a second longitudinal end (32) and a body centerline extending within the body between the first and second longitudinal ends, the body having a first position in which the body centerline is straight, and the body having a second position in which the body centerline curved as depicted in Fig. 5, wherein the body flexes about an axis that deviates from being parallel with the longitudinal axis of the body (see Figs. 1-6; col.2, lines 33-67; col.3, lines 1-22).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5-12, 14, 15, 19-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application (JP 10-266510).

Japanese Patent Application'510 discloses a flexible side/hand rail comprising a flexible body (2A2) including a flexible material having a plurality of laterally extending

apertures/notches and having a central rail member aperture wherein an articulated rail member (2A1) positioned inside the flexible body through the central rail member aperture, the flexible body having a plurality of repeating segments along a longitudinal axis of the body, each repeating segment is pivotable relative to adjacent repeating segments as depicted in Fig. 5 (see Figs. 1-7; English translated abstract).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application'510 in view of Cambell, Jr. et al. The teachings of Japanese Patent Application'510 have been discussed above.

Japanese Patent Application'510 fails to disclose or fairly suggest the flexible material of the body is made of foam. Cambell, Jr. et al discloses a bendable foam covered rod-like article

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comprising of a flexible body including a flexible material/foam (14) and a rail member positioned inside the flexible body as depicted in Fig.1 (see col.4, lines 9-67; col.5, lines 1-17).

Therefore, in view of Cambell, Jr. et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to replace the covering with the foam material in order to protect the object to be contacted with and enhance the softness of the rail covering.

With respect to the triangular shaped in cross section for the laterally extending apertures of the flexible body, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have a triangular cross section for the apertures of the flexible body in order to provide the more freedom of the flexibility to the body by shaping the side rail covering to be a triangular shape.

Allowable Subject Matter

11. Claims 27-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

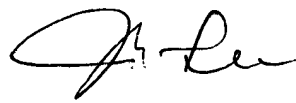
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references cited disclose a bendable foam covered rod-like article and method and apparatus, a method for forming a hollow work piece using a snake tool and a bendable patient support.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
April 26, 2004



Jong-Suk (James) Lee
Primary Examiner
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